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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,471	11/08/1999	DENISE R. COOPER	114205.1200	5279

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SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
2421 N.W. 41ST STREET
SUITE A-1
GAINESVILLE, FL 326066669

EXAMINER

FALK, ANNE MARIE

ART UNIT PAPER NUMBER

1632

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/435,471

Applicant(s)

COOPER ET AL.

Examiner

Anne-Marie Falk, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-38 and 42-47 is/are allowed.
- 6) ☒ Claim(s) 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/6/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment filed February 20, 2004 has been entered. Claims 1, 3-7, and 19-29 have been cancelled.

Accordingly, Claims 30-47 remain pending in the instant application.

The response filed February 20, 2004 indicates that an earlier Sequence Listing filed July 6, 2001 was used in performing the sequence search. However, a more recent Sequence Listing filed October 28, 2002 presents a different sequence designated SEQ ID NO: 9 as compared to the earlier-filed Sequence Listing. This issue was discussed in the telephonic interview of January 29, 2004. Both parties agreed that the most current version of the Sequence Listing was not used in conducting the sequence search relied upon in the previous Office Action (mailed 1/5/04). Accordingly, a new search has been conducted and the following new grounds of rejection apply.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,703, 054 (Bennett et al., 1997).

Claim 39 is directed to a primer comprising a nucleic acid sequence capable of hybridizing to at least 15 consecutive bases of the sequence of SEQ ID NO: 9. Claim 40 is directed to a kit comprising a

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set of primers for detection of a polynucleotide sequence comprising SEQ ID NO: 9. Claim 41 is directed to a nucleic acid probe capable of hybridizing to at least 15 consecutive bases of SEQ ID NO: 9.

In the Sequence Listing filed November 1, 2002, SEQ ID NO: 9 is a human DNA sequence 39 nucleotides in length.

Bennett et al. (1997) disclose the following sequence as SEQ ID NO: 30 (see column 29):

ACTTAGCTCT TGACTTCGGG

The oligonucleotide is 20 nucleotides in length and hybridizes to SEQ ID NO: 9 as follows:

5' CCC GAA GTC AAG AGC TA 3'	SEQ ID NO: 9 (of the instant application)
3' GGG CTT CAG TTC TCG ATT CA 5'	SEQ ID NO: 30 (of USPN 5,703,054)

Thus, the oligonucleotide disclosed by Bennett et al. forms 17 base pairs with the sequence of SEQ ID NO: 9.

Thus, the claimed invention is disclosed in the prior art.

Claims 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank Accession No. AA875851 (March 25, 1998).

GenBank discloses a nucleic acid of human kidney origin that is 46 nucleotides in length. The sequence aligns to SEQ ID NO: 9 forming 22 base pairs across a segment 29 nucleotides in length. See enclosed sequence alignment. Thus, the disclosed nucleic acid meets the limitation of "hybridizing to at least 15 consecutive bases of the sequence of SEQ ID NO: 9."

Thus, the claimed invention is disclosed in the prior art.

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Conclusion

Claims 30-38 and 42-47 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to William Phillips, whose telephone number is (571) 272-0548.

Anne-Marie Falk, Ph.D.



ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER